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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/709,930	09/09/1996	PHILIP S. GREEN	000287-00482	7111

20350 7590 12/17/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

GARLAND, STEVEN R

ART UNIT PAPER NUMBER

2125

DATE MAILED: 12/17/2003

55

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/709 930	9/9/06	Green	002875-004820US

EXAMINER	
Garland	
ART UNIT	PAPER NUMBER
2125	55

DATE MAILED:

INTERVIEW SUMMARY

All participants (applicant, applicant's representative, PTO personnel):

(1) Mr. Barrish (3) _____
(2) Mr. Garland (4) _____

Date of Interview 12/15/03

Type: ☐ Telephonic ☐ Televideo Conference ☒ Personal (copy is given to ☐ applicant ☒ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No If yes, brief description: _____

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: 118, 139, 141

Identification of prior art discussed: Wilk and Heer

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: whether the subject matter of claim 139 could now be claimed due to filing of an RCE. Articulation and pivoting coupling were discussed and would be further emphasized in the response. Whether additional subject matter added to claim 139 would make new claims patentable if the subject matter of claim 139 was unpatentable.
(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☐ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

Examiner Note: You must sign this form unless it is an attachment to another form.

Steven P. Garland

Manual of Patent Examining Procedure, Section 713.04 Substance of Interview must Be Made of Record

Except as otherwise provided, a complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview.

§1.133 Interviews

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111 and 1.135. (35 U.S.C. 132)

§ 1.2. Business to be transacted in writing. All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, pointing out typographical errors or unreadable script in Office actions or the like, or resulting in an examiner's amendment that fully sets forth the agreement are excluded from the interview recordation procedures below.

The Interview Summary Form shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication.

The Form provides for recordation of the following information:

- Application Number of the application
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (personal or telephonic)
- Name of participant(s) (applicant, attorney or agent, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the claims discussed
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
- The signature of the examiner who conducted the interview
- Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check a box at the bottom of the Form informing the applicant that he need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview:

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he feels were or might be persuasive to the examiner,
- 6) a general indication of any other pertinent matters discussed, and
- 7) If appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter to complete the reply and thereby avoid abandonment of the application. (37 CFR 1.135(c)).

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him. If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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FACSIMILE COVER SHEET

Date: 12/11/03	Client & Matter Number :	No. Pages (including this one): 9			
To: EXR. STEVEN R. GARLAND	At Fax Number: 703 746-7240	Confirmation Phone Number: 703 305-9759			
From: MARK BARRISH					
Message: PER OUR DISCUSSION, ATTACHED ARE SOME CLAIMS I HOPE TO DISCUSS WITH YOU ON MONDAY UNOFFICIAL - PLEASE DO NOT ENTER FOR DISCUSSION <u>ONLY</u> THANKS, MARK BARRISH					
Original Will:	BE SENT BY MAIL	BE SENT BY FEDEX/OVERNIGHT COURIER	BE SENT BY MESSENGER	X	NOT BE SENT

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Amendments to the Claims:

Please cancel claims 118, 138, and 141; please amended 162; and please add new claims 163-165 as follows. The listing of claims will replace all prior versions, and listings, of claims in the application:

1. - 114. (Canceled)

115. (Original) A method for allowing a user to remotely control a movement of a surgical instrument having a tip, the method comprising the steps:

- a) establishing an original position of the surgical instrument tip;
- b) inputting a command provided by a user to move the surgical instrument in a desired direction relative to an object displayed on a display device;
- c) computing an incremental movement of the surgical instrument based on the command provided by the user and on the original position of the surgical instrument;
- d) moving the surgical instrument in the desired direction so that the surgical instrument tip always moves in a direction commanded by the user.

116. - 118. (Canceled)

119. (Original) A medical robotic system, comprising:

a robotic arm;
a coupler that pivotally attaches to the arm;
an endoscopic surgical instrument that is held by said coupler; and
a controller having a handle, the controller in electrical communication with the robotic arm; and

wherein movement at the controller produces a proportional movement of the robotic arm and surgical instrument, and wherein said endoscopic surgical instrument is an articulable endoscopic surgical instrument.

120. (Original) A medical robotic system, comprising:

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a robotic arm;
a coupler that pivotally attaches to the arm;
an articuable endoscopic surgical instrument that is held by said coupler; and
a controller having a handle, the controller in electrical communication with the robotic arm; and

wherein movement at the controller produces a proportional movement of the robotic arm and the articuable surgical instrument, and wherein the articuable surgical instrument comprises a base, a pivot linkage, and a distal end.

121. (Original) The system of claim 120 wherein a movement at the controller results in corresponding movement of the distal end of the articuable surgical instrument relative to the base of the articuable surgical instrument.

122. (Original) The system of claim 121 wherein a cauterizer is attached at the distal end of the articuable surgical instrument.

123. (Previously presented) The method of claim 115, further comprising:

- 1) providing a first articulate arm, a controller and an input device which receives input commands, the first articulate arm in electrical communication with the controller and the controller in electrical communication with the input device;
- 2) cutting at least one incision into a patient;
- 3) attaching the surgical instrument to the first articulate arm, the surgical instrument having a shaft supporting the surgical instrument tip;
- 4) inserting said surgical instrument into the patient through the at least one incision such that a first portion of the shaft is outside the patient and a second portion of the shaft is inside the patient;
- 5) generating movement commands to move said surgical instrument in accordance with a surgical procedure being performed, wherein said first articulate arm moves

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said surgical instrument in accordance with the movement commands such that said first portion of the shaft and said second portion of the shaft move; and

6) removing the surgical instrument from the patient.

124. (Original) The method of claim 123 wherein said surgical instrument is a grasper.

125. (Original) The method of claim 123 wherein the surgical instrument is a cauterizer.

126. (Original) The method of claim 123 wherein the surgical instrument is a cutting blade.

127. - 151. (Canceled)

[Applicants have previously avoided the use of claim numbers 152 - 160 so as to avoid confusion with claims proposed to be added during the interferences.] *See Amendment fax-filed November 27, 2002.*

161. (Original) The method of claim 123, further comprising:

inputting the commands by moving a handle, the handle supported by an input linkage and having a sensor, wherein the surgical instrument comprises an articulable surgical instrument having a wrist joint coupling the shaft to the surgical instrument tip, wherein said first articulate arm moves said surgical instrument while the first portion of the shaft is outside the patient and the second portion of the shaft is inside the patient by rotating the shaft about an axis of the shaft, by translating the shaft along the axis of the shaft, and by articulating the wrist joint within the patient, the surgical instrument movement proportional with the handle movement; and

operating a joint coupling a first tip structure and a second tip structure of the surgical instrument by actuating the sensor of the handle.

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162. (Currently Amended) ~~The system of claim 119,~~ A medical robotic system, comprising:

a robotic arm;

a coupler that pivotally attaches to the arm;

an endoscopic surgical instrument that is held by said coupler; and

a controller having a handle, the controller in electrical communication with the robotic arm; and

wherein movement at the controller produces a proportional movement of the robotic arm and surgical instrument, and wherein said endoscopic surgical instrument is an articulable endoscopic surgical instrument; and

wherein the articulable surgical instrument comprises a shaft coupled to a surgical instrument tip by a wrist joint, the articulable surgical instrument insertable into a patient via an incision such that a first portion of the shaft is outside the patient and a second portion of the shaft is inside the patient; wherein the handle has a sensor and is supported by a linkage, wherein movement of the handle produces rotation of said first portion of the shaft and the second portion of the shaft about an axis of the shaft extending through the incision, translation of said shaft along the axis, and articulation of said wrist joint, and wherein actuation of the sensor of the handle produces operation of the surgical instrument tip.

Please add claims 163-165 as follows:

163. (New) A system that allows a user to control a movement of a surgical instrument, wherein the surgical instrument is coupled to a display device that displays an object, comprising:

a mechanism that moves the surgical instrument, said mechanism having an original position and including a first linkage arm coupled to the surgical instrument and a first actuator which can rotate said first linkage arm and the surgical instrument in a plane perpendicular to a first axis, said first actuator being coupled to a linear actuator which can translate said first linkage arm along an axis parallel with the first axis;

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an input device that receives a command to move the surgical instrument in a desired direction relative to the object displayed by the display device; and,

a controller that receives said command to move the surgical instrument in the desired direction, computes a movement of said mechanism based on said command and the original position of said mechanism so that the surgical instrument moves in the desired direction, and provides output signals to said mechanism to move said mechanism said computed movement to move the surgical instrument in the desired direction commanded by the user.

164. (New) The system of claim 163, wherein the input device has a handle, and

wherein movement at the input device produces a proportional movement of the surgical instrument.

165. (New) The system as recited in claim 163, wherein said controller is a computer which receives input signals from said input device and provides output signals to said controller to move the surgical instrument.

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PATENTREMARKS

Claims 115, 119-126, and 161-165 are pending. Applicants gratefully acknowledge the allowance of claims 115, 123-126, and 161. Prior dependent claims 162 was indicated as defining patentable subject matter, but was objected to as depending upon a non-allowed base claim. Claim 162 has been amended to independent form by incorporating each of the elements of claim 119 from which it previously depended, so that claim 162 should also now be in condition for allowance.

Prior claims 138 and 141 were treated as having been canceled from the application, while amendments to prior claim 118 have not been entered. Claims 118, 138, and 141 are canceled in the present amendment so as to clarify issues now before the Examiner. Claims 119-122 were rejected as allegedly being unpatentable over the cited art.

Reexamination and reconsideration of all pending claims, as amended, are respectfully requested.

The Subject Matter of Prior Claims 118, 138 and 141

Applicants note that the subject matter of added claims 163, 164, and 165 correspond exactly to the subject matter of prior claims 138, 118, and 141, respectively, as Applicants sought to amend those claims in a prior Amendment under 37 C.F.R. § 1.116, filed on November 27, 2002. Applicants note that the Examiner declined to enter amendments to claims 138 and 141, treating those claims as having been canceled and citing M.P.E.P. § 1214.06. Likewise, amendments to claim 118 (so as to make that claim depend from claim 138) were not entered, again citing M.P.E.P. § 1214.06.

Applicants respectfully note that section §1214 of the M.P.E.P. specifies procedures to be followed in an application upon its return to *ex parte* prosecution after entry of a decision by the Board. As noted by the Examiner, §1214.06 addresses the actions to be taken when the Examiner is sustained in whole or in part, and sets forth limitations on the procedures under which the Applicant is allowed to continue prosecution. However, since return of the present application from the Board, Applicants have filed a Request for Continued Examination (RCE). Hence, pursuant to §706.07(h)(XI)(A) of the M.P.E.P., "the filing of an RCE

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(accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit. . . *result(s) in the finality of the rejection or action being withdrawn and the submission being considered.*" Moreover, §706.07(h)(XI)(A) explicitly references M.P.E.P. § 706.03(w), which describes the limitations on the effects of the prior appeal, and specifically the "*res judicata*" effect of a Decision by the Board of Patent Appeals and Interferences. Per §706.03(w), while *res judicata* may constitute a proper ground for rejection, the courts have materially restricted the use of *res judicata* rejections so that such a rejection should "be applied only where the earlier decision *was a decision* of the Board of Appeals." Per §706.03(w), such *res judicata* rejections are appropriate after the Board has sustained a rejection of *the same claim* (or a patentably non-distinct claim) *if* the prior adjudication on that claim came down from the Board of Appeals. While the §706.07(h)(XI)(A) also explicitly references § 1214.06, per the wording of the former the latter comes back into play only regarding new grounds for rejection from the Board.

Regarding the subject matter of current claim 163 (corresponding to appealed claim 139), the decision of December 22, 2000 in the present application stated the following on page 2: "Claim 139 is objected to as being dependent upon a rejected base claim." Applicants see no rejection of claim 139 by (or sustained by) the Board. Moreover, the Examiner previously held claim 139 to be patentably distinct from appealed claim 138 (the rejection which was sustained by the Board). Applicants do now understand that the Examiner was following the instructions of § 1214.06 in canceling prior claims 138 and 141, so that Applicant's prior amendments to claim 118 made little sense. Applicants do not, however, see any basis for asserting that applicants cannot, after proper filing of an RCE, seek patent protection for the subject matter of prior claim 139, which has was not rejected by the Board nor the examiner, and was in fact indicated as defining patentable subject matter (although objected to on formal grounds).

As Applicants have complied with all requirements for a proper RCE, as the M.P.E.P. requires that appropriate amendments (such as those now being requested) after proper filing of an RCE be entered, and as the M.P.E.P. provides no basis for declining to enter

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proposed added claims (such as adding claim 163) after proper filing of an RCE, nor for rejecting those claims under *res judicata*, Applicants respectfully request that claims 163-165 be entered and examined.